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09/727,240	11/30/2000	Marc S. Phillips	PA990382	4366

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Qualcomm Incorporated  
Patents Department  
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EXAMINER

BEAMER, TEMICA M

ART UNIT PAPER NUMBER

2681

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/727,240

Applicant(s)

PHILLIPS, MARC S.

Examiner

Ternica M. Beamer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed May 17, 2005 have been fully considered but they are not persuasive. Applicant argues that the programming and utilization of the soft keys in Overy (taken alone or in combination) used for speed-dialing does not require navigation through a hierarchical menu structure to operate/access features of the phone. The examiner, however, disagrees.

The examiner believes that Overy reads on the present claims as evidenced by the fact that the user of the phone is able to select the function associated with a programmable key. Overy states that "any" feature can be performed easier by a soft key (inherently after the feature has been programmed/associated with the designated soft key) because of the reduction of the number of keystrokes required to reach the function in the menu (col. 1, line 63-col. 2, line 7). Further, in the embodiment wherein the user is programming speed-dialing, the user has to go through different menus (screen prompts) to store the desired function for the programmable key (col. 6, lines 9-18).

Based on the above arguments, the claims stand rejected as set forth below.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 6, 8-12, 14, 15, 17 and 21-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Overy et al (Overy), U.S. Patent No. 6,122,530.

Regarding claims 1, 17, 21 and 22, Overy discloses the method/handset of selectively operating features of a personal wireless communication handset, comprising the steps of: initiating a program mode in a controller of the handset (col. 4, lines 40-45); entering a sequence of inputs (telephone numbers/any feature required to use multiple keystrokes) using a keypad on the handset, said sequence causing the controller to navigate through one or more stages of a hierarchical menu structure (col. 1, line 63-col. 2, line 7, col. 4, lines 40-45); storing said sequence of inputs in a memory (col. 4, lines 33-45); defining a procedure for retrieving the sequence of inputs from the memory to navigate through the hierarchical menu structure; and pressing a key on the keypad to initiate the procedure for retrieving the sequence of inputs from the memory to operate selected features (speed dialing) of the handset (i.e., associating soft keys with programmed numbers) (col. 1, line 63-col. 2, line 7, col. 4, lines 33-45).

Regarding claims 11 and 14, Overy discloses a personal communication handset comprising: a display (5); a user-interface (9); a controller (4) coupled to the display and configured to communicate with said display so as to display a set of text descriptions allowing a user to view features of the personal communication handset, said controller

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also coupled to the user-interface and configured to receive commands from said user-interface causing the controller to navigate through one or more stages of a hierarchical menu structure in order to access features of said personal communication handset (col. 1, line 63-col. 2, line 7, col. 3, lines 13-17, lines 32-35, col. 4, lines 32-45); a memory device coupled to the controller, such that said controller can retrieve data stored on said memory device (col. 3, lines 55-62, col. 4, lines 32-45); and a macro program stored in the memory device, said macro program comprising a set of user-interface inputs (speed dial numbers) to navigate through the hierarchical menu structure for controlling at least one feature of the wireless communications device (col. 1, line 63-col. 2, line 7, col. 4, lines 33-45).

Regarding claims 2, 12, 15 and 23, Overy discloses the method/handset of claims 1, 11, 14 and 22 wherein the user interface is a keypad (col. 3, lines 18-32).

Regarding claims 6 and 19, Overy discloses the method of claims 2 and 17 wherein the procedure for retrieving the sequence of inputs uses a soft key (col. 4, lines 40-45).

Regarding claim 8, Overy discloses the method of claim 1 wherein a menu list displays macros stored in said memory (stored telephone numbers) (col. 4, lines 55-66).

Regarding claim 9, Overy discloses the method of claim 8 wherein the menu list displays the defined procedure for retrieving a macro (i.e., which soft key to press in order to active speed dialing for a particular stored number) (col. 5, lines 1-18).

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Regarding claim 10, Overy discloses the method of claim 1 wherein the macro operates a selected plurality of features (i.e., plurality of numbers stored) (col. 4, lines 40-45).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3, 5, 13, 16, 18, 20, 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Overy and Schmidt, U.S. Patent No. 6,360,110.

Regarding claims 3 and 24, Overy discloses the method of claims 1 and 23 as described above. Overy, however, fails to disclose wherein the user interface is a voice recognition device.

In a similar field of endeavor, Schmidt discloses a selectable assignment of a default call address. Schmidt further discloses wherein speed dial numbers stored in a memory of a phone can be dialed via a voice command (col. 6, lines 56-59).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Overy with the teachings of Schmidt for the purpose of implementing hands-free operation of a mobile terminal, thereby freeing up the hands of a user in order to perform other tasks such as driving a vehicle.

Regarding claims 5, 13, 16 and 18, Overy discloses the method/handset of claims 2, 12, 14, 17 as described above. Overy, however, fails to disclose wherein the procedure for retrieving the sequence of inputs uses a dedicated hot key.

In a similar field of endeavor, Schmidt discloses wherein a method for retrieving a sequence of inputs uses a dedicated hot key (col. 2, lines 4-13).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Overy with the teachings of Schmidt for the purpose of helping a user of the phone to easily and quickly dial a stored number.

Regarding claim 26, the combination of Overy and Schmidt discloses the method of claim 24 and further discloses wherein the procedure for retrieving the sequence of inputs uses a dedicated hot key (Schmidt, col. 2, lines 4-13).

Regarding claim 20, Overy discloses a personal wireless communication handset comprising: a display (5); a keypad (9); a controller (4) coupled to the display and configured to communicate with said display so as to display a set of text descriptions allowing a user to view features of the personal wireless communication handset (col. 3, lines 13-35), said controller also coupled to the keypad and configured to receive commands from said keypad to navigate through one or more stages of a hierarchical menu structure in order to access features of said personal wireless communication handset (col. 1, line 63-col. 2, line 7, col. 3, lines 13-35); a memory device coupled to the controller, such that said controller can retrieve data stored on said memory device; and a macro program stored in the memory device, said macro program comprising a

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set of keypad inputs to control at least one feature of the wireless communications device (col. 3, lines 54-64).

Overy, however, fails to disclose wherein the user interface has a dedicated hot key and wherein the macro program is initiated by pressing the hot key.

In a similar field of endeavor, Schmidt discloses wherein a method for retrieving a sequence of inputs uses a dedicated hot key (col. 2, lines 4-13).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Overy with the teachings of Schmidt for the purpose of helping a user of the phone to easily and quickly dial a stored number.

6. Claims 4 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Overy in view of Reber, et al Reber, U.S. Patent No. 6,002,946.

Regarding claims 4 and 25, Overy discloses the method of claims 1 and 23 as described above. Overy, however, fails to disclose wherein the user interface is a stylus device.

In a similar field of endeavor, Reber discloses a handheld device having an optical data reader. Reber, further discloses wherein the handheld device has a stylus user interface that is used to initiate commands (col. 2, lines 34-42).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Overy with the teachings of Reber since stylus type interfaces are well known devices used to access/initiate commands.



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7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Overy in view of Frederiksen et al (Frederiksen), U.S. Patent No. 6,122,530.

Regarding claim 7, Overy discloses the method of claim 2 as described above. Overy, however, fails to disclose a procedure for retrieving the sequence of inputs using an overridden key on the keypad.

In a similar field of endeavor, Frederiksen discloses a phone number database for a telephone. Frederiksen further discloses a procedure for retrieving the sequence of inputs using an overridden key on the keypad (as described above in the 112 rejection) (col. 5, lines 6-43).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Overy with the teachings of Frederiksen for the purpose of helping a user of the phone to easily and quickly dial a stored number.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Temica M. Beamer whose telephone number is (571) 272-7797. The examiner can normally be reached on Monday-Thursday (alternate Fridays) 7:00am-4:00pm.

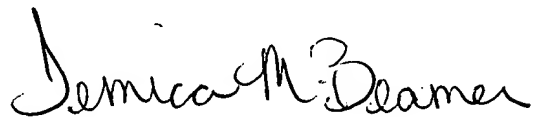
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Temica M. Beamer  
Primary Examiner  
Art Unit 2681

June 26, 2005

A handwritten signature in black ink that reads "Temica M. Beamer". The signature is written in a cursive style with a large, stylized "T" and "B".

TEMICA BEAMER  
PRIMARY EXAMINER